

RESPONSE TO RESTRICTION REQUIREMENT

This paper is being submitted in response to a restriction requirement, mailed January 22, 2009, in which claims 1-40 were subject to a three way restriction. The Patent and Trademark Office identified three allegedly distinct groups of claims: Group I (claims 1-13, 18-23, and 30) directed to a composite material; Group II (claims 14-17 and 24-29) directed to a process of preparing a composite material; and Group III (claims 31-40) directed to products prepared from a composite material. This paper is timely filed as it is concurrently filed with a petition for a one month extension of time and payment of the requisite fee.

Applicants elect Group I, directed to a composite material. Should the subject matter recited in the Group I claims be found allowable, the applicants respectfully request that the PTO reconsider the restriction requirement and request rejoinder of the subject matter recited in the non-elected claims. See MPEP § 821.04(a). Applicants further respectfully traverse the restriction requirement, offering the following remarks.

Because this application is a U.S. national phase of an international (PCT) application, unity of invention practice—not restriction practice—is applicable. See MPEP § 1893.03(d). Accordingly, the standard for making a lack of unity-of-invention finding requires a showing by the PTO that (a) there are different groups of claims present in one application, and (b) **why** each of the groups lacks unity relative to each other group, **specifically describing** the unique special technical feature in each group. *Id.* A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature that defines the contribution, which each claimed invention, when considered as a whole, makes over the prior art. The Examiner's attention is directed to the examples in Annex B, Part 2 of the PCT Administrative Instructions as amended July 1, 1992, contained in Appendix AI of the MPEP (8th ed., Rev. 2, May 2004).

While the action has set forth three different groups of claims, it is respectfully submitted that the action provides neither an adequate explanation as to why the claims of each group lack unity relative to the claims of each other group, nor an adequate explanation specifically describing the unique special technical feature in each group. Both explanations are required to support the lack of unity-of-invention rejection. MPEP § 1893.03(d). The

Patent Office has merely recited that the claims lack the same or corresponding special technical features, without further explanation beyond saying that “a composite material comprising polymeric material into which is incorporated a dilatant polymeric material – has been revealed by WO 03/022085 to Plant (Abstract)” (see pp 2-3 of Action). Applicants respectfully request clarification of this statement, as it appears the Patent Office is actually arguing that the claimed subject matter *is* linked by the special feature of a composite material. Applicants further respectfully request reconsideration of the restriction requirement, and an explanation of the unique special technical features of each group, to properly satisfy the requirements for imposition of restriction of the claims.

Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, the examiner is urged to contact the undersigned.

Dated: March 20, 2009

Respectfully submitted,
Electronic signature: /Shelley C. Danek, Reg.
#57,712/
Shelley C. Danek
Registration No.: 57,712
MARSHALL, GERSTEIN & BORUN LLP
233 S. Wacker Drive, Suite 6300
Sears Tower
Chicago, Illinois 60606-6357
(312) 474-6300
Attorney for Applicant